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FILED
JUL 16 1963
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1962.

No. 254

HENRY J. FROLICH, D/B/A ENCINO CHEMICALS,
Petitioner,

vs.

MILES LABORATORIES, INC.,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT.

BRIEF FOR RESPONDENT IN OPPOSITION TO THE GRANTING OF THE PETITION.

WILLIAM T. WOODSON,
Prudential Plaza,
Chicago 1, Illinois,
Attorney for Respondent.

WOODSON, PATTISHALL & GARNER,
Prudential Plaza,
Chicago 1, Illinois,
Of Counsel.

THE SOUTHCOTT-WARREN PRINTING COMPANY, CHICAGO

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I.

HISTORY OF THE LITIGATION.

The litigation between the parties arose by the filing by respondent of an action against petitioner for trademark infringement and unfair competition in the Southern District of California.

Respondent alleged that petitioner's trademark MILK-O-SELTZER for a remedy for headache and upset stomach was a colorable imitation of and an infringement of respondent's federally registered trademark ALKA-SELTZER for a

similar product, and that the use of said trademark by petitioner constituted unfair competition with respondent.

The District Court held that there was no infringement nor unfair competition and dismissed the complaint (195 F. Supp. 256). An appeal was filed in the United States Court of Appeals for the Ninth Circuit. The judgment of the District Court was affirmed by a split decision (296 F. 2d 740). A petition for certiorari was filed in this Court based largely upon conflict between the various Circuits on similar trademark questions. The petition was denied (369 U. S. 865). The petitioner thereupon filed a suit against respondent in the Southern District of California for damages in the sum of $1,026,400. Respondent filed a motion for summary judgment under Rule 56 of the Federal Rules of Civil Procedure. The motion was granted. Petitioner filed an appeal in the United States Court of Appeals for the Ninth Circuit. The Judgment was affirmed (316 F. 2d 87).

II.

REASONS FOR NOT GRANTING THE PETITION.

1. There is no conflict with decisions of other Circuits.
2. There is no question of federal law involved which has not been decided by this Court.
3. The decisions below were right.

III.

ARGUMENT.

1. The Decisions Below.

The District Court in granting respondent's motion for summary judgment held:

1. Defendant had probable cause for instituting and prosecuting said Civil Action No. 336-60-MC against plaintiff.
2. That the defendant did not bring said action, No. 337-60-MC against plaintiff with malice.
3. That there is no other genuine issue as to any material fact remaining in the action.
4. That defendant is entitled upon this motion for summary judgment to a judgment dismissing the action.

The Court of Appeals for the Ninth Circuit in affirming the judgment of the District Court in granting respondent's motion for summary judgment said:

> "What Mr. Frolich's understanding of the difference might be is of little consequence here, because of the court's finding 'that probable cause existed for Miles Laboratories' bringing the litigaton, and its finding of a lack of malice resting on much more than Mr. Frolich's inadvertent statement.
>
> "Mr. Frolich earnestly believes that because he won the first suit that there was no probable cause for Miles Laboratories' bringing it, and that its institution had to be the result of 'noncriminal' malice. Not only did the court below find otherwise, but in our opinion it could have found in no other way, on the facts then before it and the applicable law. Rule 56(c) Fed. R. Civ. P. California law is applicable. *Erie R. Co.* v.

Tompkins, 1938, 304 U. S. 64; *Cf.* Restatement of Torts, Sec. 674, *et seq.* *Eastin* v. *Bank of Stockton*, 1884, 66 Cal. 123, 4 Pac. 1106; *C. D. Lotts* v. *Bob Whitworth*, 1946, 76 Cal. App. 2d 601.

"Actions for malicious prosecution are a disfavored action for reasons of public policy. *Haydee* v. *Morton*, 1935, 8 Cal. App. 2d 730, 48 P. 2d 709; *Sebastian* v. *Crowley*, 1940, 38 Cal. App. 2d 194, 202, 101 P. 2d 120.

> 'There is nothing improper in bringing a civil suit for personal ends, and consequently it is necessary to prove either actual ill will or some ulterior purpose distinct from that of enforcement of the alleged cause of action. Restatement of Torts, Sec. 676.'

"Witkin, Summary of California Law (6th Ed., p. 669).

Advice of counsel has 'the usual effect of supplying probable cause.' Restatement of Torts, Sec. 675(b). *Citizens Bank* v. *Hoffman*, 44 Cal. App. 2d 814, 113 P. 2d 211."

This Court in *Stewart* v. *Sonneborn*, 98 U. S. 187, said at page 202:

> "* * * any person believing himself to have a claim against another, having probable cause for such belief, has a right, by law, to sue therefor, subject only, if his claim be adjudged false, to pay the costs of suit."

In *Crescent Live Stock Co.* v. *Butchers' Union*, 120 U. S. 141, this Court said, page 149:

> "And when there is no dispute of fact, the question of probable cause is a question of law for the determination of the court. *Stewart* v. *Sonneborn*, 98 U. S. 187, 194. Want of probable cause and the existence of malice, either express or implied, must both concur to entitle the plaintiff in an action for a malicious prosecution to recover. So that if probable cause is shown, the defense is perfect, notwithstanding the defendant in instituting and carrying on the action may have been actuated solely by a motive and intent of

malice. If he had probable cause to institute his action, the motives by which he was actuated and the purposes he had in view are not material."

2. The Granting of Defendant's Motion for Summary Judgment Was Proper.

Respondent filed its motion for summary judgment under Rule 56 of the Federal Rules of Civil Procedure which provides in part:

> "The judgment sought shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law."

The motion was supported by an affidavit by the Vice President of the respondent, which stated that the Civil Action was filed without malice and upon advice of counsel. The petitioner offered no affirmative testimony to rebut or discredit this affidavit.

In *Byrnes* v. *Mutual Life Insurance Company of New York*, 217 F. 2d 497, (9 Cir., 1954), on the question of the lack of affirmative evidence to discredit the testimony by affidavit filed in support of a motion for summary judgment it was held, page 501:

> "In the last analysis, there is no general pattern that can be applied. In each case we must determine whether there is a triable issue of fact. One of the general tests applied is this: If the testimony presented by the affidavits is such that a directed verdict would have to be granted, the court is justified in granting summary judgment unless affirmative testimony is offered to discredit the testimony."

It was respondent's position that there was no genuine issue as to any material fact and that respondent was entitled to judgment as a matter of law since it had probable

cause in instituting the initial civil proceedings. The district court so found and so held and the court of appeals affirmed.

In *Community of Roquefort* v. *William Faehndrich, Inc.*, 303 F. 2d 494 (2 Cir., 1962), the Court said, page 496:

> "The purpose of summary judgment is to dispose of cases in which 'there is no genuine issue as to any material fact and * * * the moving party is entitled to judgment as a matter of law.'"

In *Hurd* v. *Sheffield Steel Corp.*, 181 F. 2d 269 (8 Cir., 1950), the Court said, page 271:

> "If it appears from the pleadings, affidavits, admissions or depositions that there is no genuine issue as to any material fact and that the issue is one of law, then if the law so warrants a summary judgment should be entered. The question of the sufficiency of the evidence raises an issue of law and if, under the facts, the court would be required to direct a verdict for the moving party, then a summary judgment should be granted. *Ramsouer* v. *Midland Valley R. Co.*, 8 Cir., 135 F. 2d 101; *Parmelee* v. *Chicago Eye Shield Co.*, 8 Cir., 157 F. 2d 582, 168 A. L. R. 1130; *Sprague* v. *Vogt*, 8 Cir., 150 F. 2d 705; *Eller* v. *Paul Revere Life Ins. Co.*, 8 Cir., 138 F. 2d 403, 149 A. L. R. 1191; *Gifford* v. *Travelers Protective Ass'n*, 9 Cir., 153 F. 2d 209."

In *Byrnes* v. *Mutual Life Insurance Company of New York*, 217 F. 2d 497, (9th Cir., 1954), the Court under the caption—"The Nature of Summary Judgment" said, page 500:

> "The object of the procedure for summary judgment is not *to determine* an issue, but whether *there is an issue* to be tried. *Dulansky* v. *Iowa-Illinois Gas & Electric Co.*, 8 Cir., 1951, 191 F. 2d 881, 883.
>
> "Against the summary disposition of an issue stands the fundamental right to trial in open court by adversary proceedings, and through testimony adduced therein on the issues tendered. The late Judge Cardozo

has stated in simple, yet classic language, the condition which justifies a departure, under summary judgment, from this principle:

> 'To justify a departure from that course and the ward of summary relief, the court must be convinced that the issue is not genuine, but feigned, and that there is in truth nothing to be tried.'
>
> * * * * *
>
> "This and other Courts of Appeals have had occasion to apply the principle readily. They have generally held that if the pleadings and affidavits show that there is no issue as to any fact material to the determination of the question, summary judgment should be granted."

The District Court applied the above rule of law in granting respondent's motion for summary judgment and the Court of Appeals applied the above rule in affirming the District Court.

CONCLUSION.

This litigation is of importance only to the litigants; it is not of such gravity and general importance as to justify a review by this Court.

The petition should be denied.

Respectfully submitted,

WILLIAM T. WOODSON,
Prudential Plaza,
Chicago 1, Illinois,
Attorney for Respondent.

WOODSON, PATTISHALL & GARNER,
Prudential Plaza,
Chicago 1, Illinois,
Of Counsel.

CERTIFICATE OF SERVICE.

I, William T. Woodson, attorney for Miles Laboratories, Inc., respondent herein, and a member of the Bar of the Supreme Court of the United States, hereby certify that on the 15th day of July, 1963, I served the foregoing brief in opposition to the granting of the petition, on the petitioner by mailing three copies in a duly addressed envelope, with first class postage prepaid, to petitioner at 17500 Emelita St., Encino, California.

WILLIAM T. WOODSON,
Prudential Plaza,
Chicago 1, Illinois,
Attorney for Respondent.